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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re patent application of

Kashima, et al.

Serial No.: 09/870,009

Group Art Unit: 1631

Filing Date: May 30, 2001

Examiner: Carolyn L. Smith

For: NUCLEOTIDE SEQUENCE FOR IDENTIFYING A SOURCE OF GENETIC  
INFORMATION, AND DNA AND CELL INCLUDING THE SAME

Commissioner for Patents  
Alexandria, VA 22313-1450

**SUBMISSION OF CORRECTED TRANSLATION**

Sir:

Further to the Information Disclosure Statement filed on May 17, 2004, submitted herewith is the corrected translation for the Japanese Office Action dated March 4, 2003, submitted in the above-identified patent application, which is to replace the original translation submitted with the March 4, 2003 Japanese Office Action.

Please note that the corrected translation corrects the last paragraph on page 2 of the originally-filed translation to replace the term "growth resistance" with the term "redundant characteristics".

Approval and acknowledgment of receipt are respectfully requested.

Respectfully submitted,

Dated: 5/28/04

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YOR.418

Control. No. JP9000069  
Transmission no.: 039866  
Date issued: March 4, 2003

Notice of Grounds for Rejection

Patent Application Number: Patent Application 2000-171030  
Date conceived: February 5, 2003

Patent Examiner: Tamura, A. 8412 4B00  
Patent Applicant Agent: Furube, J. (and one other)

Applied conditions: Article 29, Section 2; Article 32;  
Article 36 and Article 37

The present application, for the reasons indicated below, should be rejected. If there are any opinions in this regard, they should be submitted within 3 months of the date of transmittal of the present notice.

Reason

1. The invention relating to the following claims of the present application could easily have been invented prior to the present application by a person of ordinary skill in the field of technology pertaining to the invention, based on the invention described in the following publications, which have been in circulation in Japan or abroad prior to the present application, or which could be publicly used through electric communication lines. Therefore, in accordance with Patent Law Article 29 Section 2, a patent may not be granted.

2. The present application, because of the following points contained in the Detailed Explanation of the Invention, does not satisfy Article 36 Section 4 of the Patent Law.

3. The invention relating to the following Claims of the present application, for the points indicated below, cannot receive a patent, according to the stipulations of Article 32 of the Patent Law.

4. The present application, for the points indicated below, does not satisfy the essential conditions of Article 37 of the Patent Law.

Record (See the Reference Citation List to obtain the citation)

#### Concerning Reason for Rejection 1

Claims 1, 4, 5, and 8-12  
Citation A

#### Remarks:

In Citation A, reference is made to being able to clarify the appearance by theoretically marking all of the artificial seedlings by the attachment of different markers to them, with a high level of activity in which micro-satellite DNA analysis has solid discriminatory ability.

Claims 1-14  
Citations A and B

#### Remarks:

In Citation B, reference is made to using a micro-satellite or SNP or the like multi-type markers, wherein the markers (particularly the SNP type) also reside in the Intoron or translation region, where the translation region does not accompany changes in the amino acid arrangement (silent changes).

Furthermore, the use of the multi-markers referred to in Citation B as the solid discrimination function referred to in Citation A, could be easily conceived by one skilled in the Art.

#### Concerning Reason for Rejection 2

"The invention referred to in Claims 3, 7 and 14 comprises "multiple types of codon attached to 2 value data using the redundant characteristics of the codon", wherein a unique (not existing in nature) appearance classification capability does not exist in the Detailed Description of the Invention,

and there is not enough clarity to enable construction of an arrangement sufficient to realize the invention. Furthermore, the Detailed Explanation of the invention is not recognized as being of sufficient clarity to enable one skilled in the Art to execute the invention relating to Claims 3, 7 and 14.

#### Reason for Rejection 3

In the invention recorded in the Scope of Patent Claims, organisms (objects) to be discriminated by their appearance include "human beings". However, action to incorporate appearance information in human beings runs counter to the common good.

#### Reason for rejection 4

Since the inventions recorded in Claims 3, 7 and 14 are inventions characterized by changing information in the DNA which is not limited to appearance discrimination information, the subject is not the same as the invention recorded in other Claims, nor is it the same as the principal component.

#### Reference Citation List

- A. Ministry of Agriculture, Forestry and Fisheries  
Technical Research Journal, Vol. 22, No. 2, pp. 27-30  
(1999)
- B. Matsubara, K., "Abbreviation of SNP Gene Multi-type"  
(Corp.) Nakayama Shoten (June 5, 2000), pp. 2-7

#### Record of the Examination Results relating to Documents of the Prior Art

- Examined Technical Field: IPC 7th Edition

C12N15/00

DB name WPI, BIOSIS, MEDLINE

#### Documents of the Prior Art

Japanese Journal of Medical Procedures (1999) Vol. 53, No. 2,  
pp. 218-226.

The record of the examination results relating to documents of the prior art does not constitute the grounds for rejection.

If there is are any points of ambiguity in relation to this Notice of Grounds for Rejection please contact the following:

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